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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/891,953 | 06/26/2001 | Jeffrey M. Valentine | BYK-001.01 | 1675 |

25181 7590 03/29/2004

FOLEY HOAG, LLP
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BOSTON, MA 02110

EXAMINER

WEAVER, SCOTT LOUIS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2645

DATE MAILED: 03/29/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,953

Applicant(s)

VALENTINE ET AL.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,17-19,24-26,28-30,33,40,42,44,52,57,58,60 and 73-75 is/are rejected.
- 7) ☒ Claim(s) 3,5-16,20-23,27,31,32,34-39,41,43,45-51,53-56,59,61-72 and 76-79 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 and 57-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23 (ln.5) "the audio data source" lacks antecedent basis, for examination purposes this will be assumed to be intended to read "the audio data". Claim 57 contains the same confusion.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 17-19, 24-26, 28-30, 33, 40, 42, 44, 52, 57-58, 60, and 73-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Krane (#5,799,063).

The claims read on Krane as follows: Krane teaches (with reference to col.2,ln.66- col.3,ln.9; col.3,ln.58-col.4,ln.10; col.6,ln.48-col.7,ln.40; col.9,ln.31-53) method and associated

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apparatus for performing method of distributing audio with at least one text document over a network, including receiving the audio data and first identifier (each audio file has a file name which is associated therewith, alternatively the identifier can be a URL which includes the file name) the audio is received from a server, a second identifier (a URL) is generated for association with the audio data and the URL is incorporated into a text document (Web Page) as pertains to claims 1, 24, 42, 52, and 57. The audio data is received from a network (the audio data is prerecorded and stored on the SoundSite audio server) as pertains to claims 2, 25, 44 and 58. With respect to claims 4, 40, 60, a media ID (file type) is generated via (col.7,ln.21-26). With respect to claim 17, 18, 26, 73, 74, the generation of the second identifier is based on the first identifier as the first and second identifier can be the same. With respect to claims 19, 30, 75 the distribution includes distributing audio data with at least one HTML document (col.6,ln.51-65). At least one database is in communication with at least one server as pertains to claims 28, (18, figure 1-2) and a telephone server (32, figure 3) is included as per claim 33. the database includes at least the first identifier as per claim 29, audio data is enabled to be retrieved via telephone as per claim 36.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

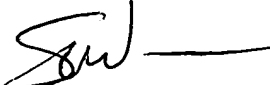
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5. Claims 3, 5-16, 20-23, 27, 31-32, 34-39, 41, 43, 45-51, 53-56, 59, 61-72, and 76-79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as the applicable prior art of record at this time does not teach the combination of limitations as presented thereby.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Monday to Sunday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645